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| | | | EXAMINER PATEL, KIRAN B | |
| | | | ART UNIT 3612 | PAPER NUMBER |

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,602

Applicant(s)

WIEBER, ROBERT

Examiner

Kiran B. Patel

Art Unit

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,5,7,10-12 and 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,8,9 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Non-Final Rejection

Election/Restriction

1. Applicant's election with traverse of group I, Species E, Fig 4, claims 1-13 is acknowledged.

Claims 14-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim.

Further, claims 2, 4, 5, 7, 10-12 are withdrawn by the Examiner from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Following claims, as best understood, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, "a layer of primer and a layer of paint are disposed directly over the adhesive material concealing the adhesive material from a surrounding environment and providing a Class A or a Class B finish" fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear because claim 1 recites "the second surface opposing the first surface" and "a structural adhesive material adhered to the first surface and the second surface" and claim 3 recites "a layer of primer and a layer of paint are disposed directly over the adhesive material concealing the adhesive material from a surrounding environment and providing a Class A or a Class B finish". There are no exposed surfaces, which can to be primed or painted. Also figures fail to show the adhesive material to be primed and painted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 6, 8-9, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graber et al. (6,679,540) and in view of ordinary skill in the art.

Regarding claims 1, 3, 6, 8-9, 13, Graber et al. (6,679,540) discloses the invention as claimed to include a first member 50 having a first flange 58 providing a first attachment surface Fig 5; a second member 70 having a second flange providing a second attachment surface Fig 5, the second surface opposing the first surface, at least one of the first member and second member being a panel; and a structural adhesive material (col 5, lines 20-60) adhered to the first surface and the second surface; .

However, Graber et al. (6,679,540) does not disclose the structural adhesive material having a tensile strength of at least 12 MPa which is applied with a mini-applicator including an extruder and the adhesive is formed from a heat activatable material that expands at a temperature encountered during at least one of the an automotive e-coat and an automotive painting operation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made (specification page 10 lines 15-16 - "A number of epoxy-

based structural reinforcing foams are known in the art and may be used to produce the structural foam adhesive material") to provide the structural adhesive material having a tensile strength of at least 12 MPa which is applied with a mini-applicator including an extruder and the adhesive is formed from a heat activatable material that expands at a temperature encountered during at least one of an automotive e-coat and an automotive painting operation, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ416.

Conclusion

4. The prior art made of record in attached Notice of Reference Cited (PTO-892) and not relied upon is considered pertinent to applicant's disclosure. This art of record shows various features similar to the applicant's invention.


5. Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Kiran B. Patel whose telephone number is 703-305-0254. The examiner can normally be reached on M-F from 8:00 to 5:00. The

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fax phone number for the organization where this application or proceeding is
assigned is (703) 872-9306.


Kiran B. Patel, P. E.
Primary Examiner
Art Unit 3612
May 4, 2004